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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/760,878 | 01/17/2001 | Takahiko Kawashima | 826.1664 | 4982 |
| 21171 | 7590 | 10/29/2004 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | ZURITA, JAMES H | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3625 | | |

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|------------------------------|------------------------|---------------------|--|
| | 09/760,878 | KAWASHIMA ET AL. | |
| | Examiner | Art Unit | |
| | James H Zurita | 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Statys

1) Responsive to communication(s) filed on 28 July 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date .
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20041021 .
5) Notice of Informal Patent Application (PTO-152)
6) Other: .

DETAILED ACTION

Response to Amendment

Applicant amendment of 26 July 2004 amended claim 6 and added claims 7-14.

Claims 1-14 are pending and will be examined.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *transaction slip data document, Management data document, data extracting unit, storing unit, transaction slip data extracting unit, transmitting unit* (claim 1) and *receiving unit* and *converting unit* (claim 3) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as

per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Specification

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

At times, applicant appears to use identical terms in the claims generically as well as specifically. It is not clear whether applicant claims a patentable distinction among the various types of data and their representation. For example, *Management data document* appears in Claims 8 and 12, but is not mentioned in the disclosures, which refer to:

| Label | Occurs | reference |
|--|---------|-------------------|
| Management data area | 2 times | |
| Management data document name | 6 times | |
| Management data document structure information | 6 times | Fig. 2, item 8, 9 |
| Management data document structure | 1 | |
| Management data | 4 times | Fig. 3, item 4 |

Claim Objections

The following claims are objected to because of the following informalities:

In claims 1-14 the term *data* renders those claims indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. *Data* is used variously as a generic term, encompassing transaction slip data, management data.

Claim 1 uses the phrase “data extracting means” when referring to a “data extracting unit.” This appears to be a word processing error. For purposes of this examination, “data extracting means” will be interpreted to refer to “data extracting unit.”

Transaction slip data and *management data* (claim 1 and claims depending from claim 1) lack antecedent basis, since the preamble refers to a *transaction slip data document* (claims 1, 5, 6, 7, 9, 11 and 13) which appears to contain both types of data.

Claims 10, 12 and 14 refer to “instruction” which is not disclosed and appears to be a word processing error. **Claims 8 and 12** refer to changing structure information of a management data document. The disclosures refer to management data document structure information, in paragraphs 42 (references 8 and 9), 65 (description of Fig. 10), 70 (description of Fig. 12) and 73 (description of Fig. 14 and 15), but do not describe how a user goes about changing a Data Type Definition, as in Fig. 10. Claims 8 and 12 will be given their broadest reasonable interpretation to mean altering a search.

Claims 4, 5, 10 and 14 contain the term “...dynamically...” which renders the claims indefinite, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For purposes of the Examination, the term will be interpreted to refer to a user being able to altering a search.

Appropriate correction is required.

Response to Arguments

Applicant's arguments with respect to claim 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Claims 7-10 are directed to a method and its steps. It is noted that certain claims appear to recite technology, but the technology is involved in a trivial manner.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al (US 6584459).

Chang discloses an EDI/XML environment that manages documents containing transaction data (applicant's transaction slip data documents) in electronic commerce, with database devices.

As per claims 1, 6, 7 and 11, Chang discloses:

- ***extracting*** data as a search item of the transaction data document therefrom. See, for example, at least Col. 20, lines 1-50.
- ***storing*** the extracted data in correlation with the transaction data; see, for example, at least Col. 20, line 55-Col. 21, line 15.
- ***searching*** the extracted data so as to extract correlated detail data. See at least Col. 21, line 16-Col. 22, line 40, Col. 23, line 52-Col. 25, line 60.
- ***transmitting*** the detail data extracted in the search step. See at least sending results to interfaces, at least Col. 5, line 12-Col. 6, line 45.

Chang does not use the labels *data extracting unit, storing unit, transaction slip data extracting unit, transmitting unit, management data, transaction slip data, management data document, document identifier*, among others.

However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will

not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as *Chang* because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

As per claim 2, *Chang* discloses that correlation between data is managed with a key that is common. See, for example, at least references to DocId, Index, Key, RID, at least Fig. 4, 6, 12-13 and related text. See also at least Col. 19, line 1- Col. 20, line 50. See also references to primary keys, foreign keys, DTDid, and other keys that correlate data among the various data objects, at least Col. 13, line 1-Col. 15, line 48.

As per claim 3, *Chang* discloses a receiving unit receiving the transmitted detail data. See, for example, at least Figs. 1, 2 and related text, and references to various units that receive transmitted detail data in XML format. *Chang* also discloses various units for converting the format of the received detail data into a format with which a transmission destination can deal, as in Fig. 2, DB2 XML extender, which converts data to and from formats used by other systems and parties.

As per claim 4 *Chang* discloses that users are allowed to define new searches for retrieval of XML documents. See, for example, at least Col. 6, lines 19-45.

As per claims 5, 9 and 13, Chang discloses that the document containing transaction data is an XML document. See, for example, at least Col. 2, line 18-Col. 3, line 24, Col. 3, line 47-Col. 4, line 18, Figs. 3, 8, 9 and related text.

As per claims 5, 10 and 14, Chang discloses that users are allowed to define new searches for retrieval of XML documents. See, for example, at least Col. 6, lines 38-45, Col. 7, line 54-Col. 8, line 3. As per claims 5, 10 and 14, a user may alter targets of a search by changing a search query according to particular tags found in XML documents, such as an author tag in XML document of Col. 5 that is used as a search parameter in the query found in Col. 20.

Claims 8 and 12 refer to changing structure information of a management data document. The disclosures refer to management data document structure information, in paragraphs 42 (references 8 and 9), 65 (description of Fig. 10), 70 (description of Fig. 12) and 73 (description of Fig. 14 and 15), but do not describe how a user goes about changing a Data Type Definition, as in Fig. 10. Claims 8 and 12 will be given their broadest reasonable interpretation to mean altering a search. Chang discloses that users are allowed to define new searches for retrieval of XML documents. See, for example, at least Col. 6, lines 38-45, Col. 7, line 54-Col. 8, line 3.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ankireddipally et al. (US 6,772,216).

Peinado et al. (US 6,775,655).

Gawlick et al. (US 6,377,953).

Murphy, Diane, The exciting role of the credit manager in the expanding e-commerce marketplace, Business Credit, v102n9 pp: 64-73 October 2000, parts 1, 2, 24 pages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
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Art Unit 3625
25 October 2004


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